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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,632	03/01/2004	Randall K. Woods	5053-63200	1334

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EXAMINER	
PHONGSVIRAJATI, POONSIN	
ART UNIT	PAPER NUMBER
3686	

NOTIFICATION DATE	DELIVERY MODE
05/22/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/790,632	WOODS ET AL.	
	Examiner	Art Unit	
	SIND PHONGSVIRAJATI	3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-22,24-42,44-61 and 100* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 4-22, 24-42, 44-61, and 100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/23/2009 has been entered.

Status of Claims

1. In response to communications received on 03/23/2009, claims 1-2, 4-6, 10, 21-22, 24-42, 44-46, 50, and 61 are currently amended, claim 100 is new, claims 1-2, 4-22, 24-42, 44-61, and 100 are now pending.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-2, 4-40, 61, and 100 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter

3. Claims 1-2, 4-20, 61, and 100 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re Bilski U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385*. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590.

4. The methods recited in claims 1-2, 4-20, 61, and 100 are not tied to a machine nor transform the underlying subject matter to a different state or thing. See Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); and Gottschalk v. Benson, 409 U.S. 63, 71 (1972).

5. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

6. A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-2, 4-20, 61, and 100 fail to meet the above requirements because they are not tied to another statutory class of invention.

7. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

8. Claims 21-22, 24-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention recites a "storage media", however, in one embodiment described in the specifications teaches of a computer readable media as:

> "Suitable carrier media include memory media or **storage media** such as magnetic or optical media, e.g., disk or CD-ROM, **as well as transmission media or signals such as electrical,**

> **electromagnetic, or digital signals**, conveyed via a communication medium such as networks and/or a wireless link."

It is interpreted by the Examiner that said "signals such as electrical, electromagnetic, or digital signals" does not belong to a statutory class since said "signals such as electrical, electromagnetic, or digital signals" is not clearly a method, apparatus, article, or composition of matter.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-2, 4-22, 24-42, 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zak et al. (US 2002/0004729 A1) in view of Burge et al. (US 2003/0200123 A1) in further view of Dormond et al. (US 4,839,822).

4. As to **Claim 1, 21, and 41 and 100,** Zak teaches a method, a program instructions executable, and an insurance claim processing system comprising: providing a graphical display comprising at least one human body representation comprising a visual image (Zak, Fig. 3-4); receiving a first selection of a first body part on at least one human body representation (Zak, Fig. 3-4); displaying in response to receiving the first selection of the first body part, a first set of input fields for input selection relating to at least one injury for the first body part (Zak, Fig. 3-4); receiving an input selection relating to at least one injury for the first body part via at least one of the input fields of the displayed first set of input fields (Zak, Fig. 4) and highlighting body parts for which input has been received in a different manner than body parts that have been selected but for which input has not been received (Zak, Fig. 4);

But, Zak does not specifically disclose providing a graphical display in an insurance claim processing system. However, Burge does disclose using a graphical representation of a human body within an insurance claim processing system (Burge, Abstract and paragraph 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a body representation for injury reports inside an insurance claim processing system in order to submit a clearer and concise claims report for

emergency medical services. One would have been motivated to use software that is capable of generating a virtual human for claims processing since it is well known in the art for human and dummy representation, such as the Bodybuilder and Anthropos products by the TecMath corporation and Mannequin Pro from NexGen Ergonomics (Burge, paragraph 49).

The combination of Zak and Burge does not specifically disclose:

after receiving the input selection relating to at least one injury for the first body part, receiving at least one selection of a second body part that is different from the first body part; removing from the display the first set of input fields for input selection relating to the at least one iniur7 for the first body part; and displaying a second set of input fields for input selection relating to at least one injury for the second body part, wherein the second set of input fields for input selection relating to the at least one injury for the second body part for the second body part is different from the first set of input fields for input selection relating to the at least one injury for the first body part; and receiving an input selection relating to at least one injury for the second body part via at least one of the displayed input fields of the displayed second set of input fields.

Dormond does teach after receiving the input selection relating to at least one injury for the first body part, receiving at least one selection of a second body part that is different from the first body part (Dormond, Fig. 3-4); removing from the display the first set of input fields for input selection relating to the at least one injury for the first body part (Dormond, Fig. 4-5); and displaying a second set of input fields for input selection

relating to at least one injury for the second body part, wherein the second set of input fields for input selection relating to the at least one injury for the second body part for the second body part is different from the first set of input fields for input selection relating to the at least one injury for the first body part (Dormond, Fig. 5); and receiving an input selection relating to at least one injury for the second body part via at least one of the displayed input fields of the displayed second set of input fields (Dormond, Fig. 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included an input section for at least one injury to a second body part that is different from the first body part for the motivation for using software that is capable of generating a virtual human for claims processing since it is well known in the art for human and dummy representation, such as the Bodybuilder and Anthropos products by the TecMath corporation and Mannequin Pro from NexGen Ergonomics (Burge, paragraph 49).

5. As to **Claim 2, 22, and 42**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein at least one of the sets of input fields comprises a listing of at least one injury for at least one subpart and the input selection comprises selecting an injury from the listing of at least one injury (Zak, Fig. 4 and paragraph 79).

6. As to **Claim 4, 24, and 44**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein the listing of at least

one injury for at least one subpart appears for the subpart when the subpart is selected from the listing of at least one subpart (Zak, Fig. 4 and paragraph 76).

7. As to **Claim 5, 25, and 45**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein the input selection information for the selected body part comprises a listing of at least one subpart and a listing of at least one injury (Zak, Fig. 4).

8. As to **Claim 6, 26, and 46**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein the input selection information for a listing of at least one injury further comprises a listing of at least one treatment (Zak, Fig. 9 and paragraph 87).

9. As to **Claim 7, 27, and 47**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein a listing of at least one treatment appears when an injury is selected from a listing of at least one injury (Zak, Fig. 9 and paragraph 87).

10. As to **Claim 8, 28, and 48**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein at least one human body representation comprises a representation of at least one of a human musculature, a human nervous system, a human skeletal system, and a human skin (Zak, Fig. 3).

11. As to **Claim 9, 29, and 49**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying a menu near the selected body part (Zak, Fig. 3-4).

12. As to **Claim 10, 30, and 50**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising distinguishing the body part selected by at least one of highlighting, outlining, and circling the selected body part (Zak, Fig. 3).

13. As to **Claim 11, 31, and 51**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising distinguishing a body part for which input selection has been received (Zak, Fig. 4 and paragraph 79).

14. As to **Claim 12, 32, and 52**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein an indicator used for a body part that is currently selected is different from a body part from which an input selection has been received (Zak, Fig. 4 element 206).

15. As to **Claim 13, 33, and 53**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying a more detailed view of a body part, in response to the body part being selected in the graphical display (Zak, Fig. 4).

16. As to **Claim 14, 34, and 54**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein the listing of at least

one subpart appears in a popup menu (Zak, Fig. 2-4, whereas the transition of screens from Fig. 2 to Fig. 4 can be interpreted as a popup menu).

17. As to **Claim 15, 35, and 55**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying a popup menu of at least one injury type for a subpart when the subpart is selected (Zak, Fig. 2-4).

18. As to **Claim 16, 36, and 56**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, wherein a subpart in the listing of at least one subpart is a node, wherein selecting the node displays a listing of at least one injury for the subpart (Zak, Fig. 4 and paragraph 79).

19. As to **Claim 17, 37, and 57**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying a listing of received input selections (Zak, Fig. 4 and paragraph 79).

20. As to **Claim 18, 38, and 58**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying an indicator next to a listing of a received input selection to indicate whether the input selection should be considered in a respective insurance claim (Zak, Fig. 2 elements 241-243).

21. As to **Claim 19, 39, and 59**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying a

listing of available human body representations (Zak, Fig. 3 element 210, where the human body representations are the front, right, left, and rear views).

22. As to **Claim 20, 40, and 60**, Zak teaches the method, the program instructions executable, and the insurance claim processing system, further comprising displaying an indicator relative to a listing of a human body representation to indicate the human body representations that have had input selections entered (Zak, Fig. 3 element 206).

23. As to **Claim 61**, Zak teaches a method, comprising:

- displaying a listing of at least one subpart associated with a body part on the human body representation (Zak, Fig. 4 and paragraph 77-79);
- receiving input corresponding to at least one body part on the at least one human body representation (Zak, Fig. 4 and paragraph 80); and
- highlighting, in response to receiving the input, at least one body part corresponding to the received input on at least one human body representation (Zak, Fig. 3-4 and paragraph 83).

But, Zak does not specifically discloses providing a graphical display in an insurance claim processing system. However, Burge does disclose using a graphical representation of a human body within an insurance claim processing system (Burge, Abstract and paragraph 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a body representation for injury reports inside an insurance claim processing system in order to submit a more clear and concise claims report for

emergency medical services. One would have been motivated to use software that is capable of generating a virtual human for claims processing since it is well known in the art for human and dummy representation, such as the Bodybuilder and Anthropos products by the TecMath corporation and Mannequin Pro from NexGen Ergonomics (Burge, paragraph 49).

24.

Response to Arguments

2. Applicant's arguments with respect to claims 1-2, 4-22, 24-42, 44-61, and 100 have been considered but are moot in view of the new ground(s) of rejection.

3. As to Applicant argument that Burge does not teach using a graphical representation of at least one human body representation. Examiner again respectfully disagrees. Fig. 10 of Burge is merely using a specification input form that is used as a baseline to draft a human dummy representation of the Claimant. From there, Burge states that third party software is used to generate the graphical representation of the said Claimant because said software is well known in the art. Examiner will provide the Mannequin Pro from NexGen Ergonomics product that Burge uses as an example to software that is well known to be used in the graphical representation of a human body.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SIND PHONGSVIRAJATI whose telephone number is (571) 270-5398. The examiner can normally be reached on Monday - Thursday 8:00am-5:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. P./
Examiner, Art Unit 3686
13 May 2009

/Gerald J. O'Connor/
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